

REMARKS

Claims 1-13 are pending in this application. By this Amendment, claims 1, 4, 12 and 13 are amended. Reconsideration based on the above amendments and following remarks is respectfully requested.

Applicants appreciate the Examiner indicating that claims 12 and 13 include allowable subject matter. Accordingly, claims 12 and 13 are rewritten into independent form including all of the features of the base claims. Applicants respectfully submit that at least claims 12 and 13 are in condition for allowance.

I. The Claims Define Patentable Subject Matter

Claims 1-13 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,057,975 to Yaeger et al. in view of 2000-100104 To Shigeru. This rejection is respectfully traversed.

Applicants respectfully submit that neither Yaeger nor Shigeru, nor their combination, teaches, discloses or suggests an angular position modifying unit to form a bend in an area of a flexible member to adjust the static angular position and a laser emitter unit to irradiate a laser beam onto the area of the flexible member while the bend is applied, as claimed in claim 1 and similarly claimed in claim 4.

Instead, Yaeger discloses a flexure arm that can be bent to a desired angle by selectively applying laser beam 42. That is, the flexure arm 26 can be heated such that slider 28 moves away from or toward the surface of disc 12. The effect of the laser is to heat a small area of the flexure arm 26 which causes the arm to bend due to localized thermal expansion.

The Office Action admits that Yaeger fails to mention a arm that holds the flexible member (magnetic head unit) or a holder for the flexible member. However, the Office Action asserts that Shigeru makes up for this deficiency. Specifically, the Office Action

asserts that Shigeru discloses the teachings of a holder for the magnetic head unit (see page 4, paragraph [0026] and Figure 4 of Shigeru). Accordingly, the Office Action asserts that it would have been obvious to modify the teachings in Yaeger with the holder in Shigeru as one would have been motivated to provide a corrected adjusting position.

It is well settled that a rejection based on 35 U.S.C. §103(a) must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad statements drawing conclusions about the teaching of multiple references, standing alone, are not “evidence.” See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the claimed combination would have been obvious. *In re Gorman*, 911 F.2d 982, 986, 18 USPQ2d 1885,

1888 (Fed. Cir. 1991) (emphasis added). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See, *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

If the PTO fails to meet this burden, then the applicant is entitled to a patent. *In re Glaug*, 62 USPQ2d 1151 (Fed. Cir. 2002).

The Examiner has failed to meet this burden. As discussed above, a rejection under 35 U.S.C. §103(a) must be based on a facts and include a showing of a suggestion, teaching or *motivation* to combine the prior art references. The only suggestion for making the asserted combination lies in the present application. As such, the combination of Yaeger and Shigeru was made using improper hindsight reconstruction of the references.

Specifically, Yaeger is fully sufficient to accomplish its stated purpose. There is no advantage that would be obtained by modifying Yaeger to use a holding unit for the flexible arm. Yaeger discloses that it has been discovered that flexure arm 26 can be bent to a desired angle by merely selectively applying a laser beam 42. The effect of the laser is to heat a small area of the flexure arm 26 which causes the arm to bend on its own due to localized thermal expansion. This provides a permanent bend.

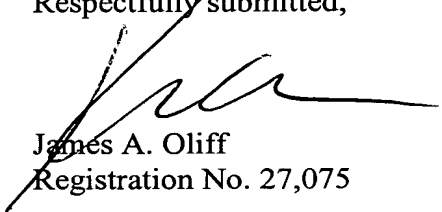
Accordingly, the combination of Yaeger and Shigeru fails to render obvious the subject matter of claims 1-13. Withdrawal of the rejection of claims 1-13 under 35 U.S.C. §103(a) is obvious in view of the combination of Yaeger and Shigeru is respectfully solicited.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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